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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/736,998
Filing Date: December 16, 2003
Appellant(s): BRESNAN ET AL.

Michael J. Cummings
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 18, 2009 appealing from the Office action mailed December 12, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,058,030	Schumacher	10-1991
7,236,950	Savage et al	6-2007

2004/0230523	Johnson	11-2004
2002/0133472	Stepno	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 52, 53, 55-57 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In *re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a

particular machine. Thus, claims 52, 53, 55-57 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 includes limitation that recites "including a step of preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may be consolidated." If messages are prevented from being consolidated even when there is a marketing rule that states that the particular marketing content may be consolidated, then it is ambiguous as to the patentable weight of the marketing rules determining step as well as the marketing rules themselves as claimed in the application if the marketing rules are being ignored.

For the purpose of expediting the prosecution the Examiner assumes the limitation to be "including a step of preventing messages from being consolidated based on the marketing rules that include a rule whether messages that include particular marketing content may not be consolidated."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 9-17, 30-32, 38-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat No. 5,058,030 to Schumacher in view of U.S. Pat No. 7,236,950 to Savage et al.

Referring to claim 1:

Schumacher discloses

A message processing system for preparing a plurality of messages to be distributed to recipients, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

A customer relationship management system coupled to the consolidator module, the customer relationship management system determining at least some of the first criteria (col 10: lines 20-27)

wherein the first criteria include marketing business rules determined by the customer relationship management system. (col 4: lines 15-21)

Schumacher does not expressly disclose wherein the marketing rules include a rule that message that include particular marketing content may, or may not, be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

Referring to claim 2:

Schumacher discloses

The message processing system of claim 1 wherein the customer relationship management system determines a template for message packages and the template is transmitted to the consolidator module for forming the message packages. (col 10: lines 31-40)

Referring to claim 3:

Schumacher discloses

The message processing system of claim 2 wherein the template includes marketing content developed by marketing tools in the customer relationship management system. (col 10: lines 31-40)

Referring to claim 9:

Schumacher discloses

The message processing system of claim 1 wherein the consolidator module is coupled to a statement applications processing module, the statement applications processing module determining at least some of the first criteria. (col 11: lines 8-11)

Referring to claim 10:

Schumacher discloses

The message processing system of claim 9 wherein the statement applications processing module provides message business data to the consolidator module for forming the message packages. (col 11: lines 8-11)

Referring to claim 11:

Schumacher discloses

The message processing system of claim 9 wherein the statement applications processing module receives data from an automated data factory having a plurality of mail production sites. (col 11: lines 5-11)

Referring to claim 12:

Schumacher discloses

The message processing system of claim 9 wherein the first criteria include sender rules received from the statement applications processing module. (col 11: lines 7-11)

Referring to claim 13:

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that whether message that include particular business content may be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

Referring to claim 14:

Schumacher does not expressly disclose that the message processing system of claim 12 wherein the first criteria include a rule that whether message that include particular business content may be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

Referring to claim 15:

Schumacher discloses

The message processing system of claim 12 wherein the sender rules include a requirement to maximize throughput of message packages, and whereby the consolidator module forms in order to maximize throughput. (col 4: lines 22-39)

Referring to claim 16:

Schumacher discloses

The message processing system of claim 12 wherein the sender rules include a requirement to minimize mail production costs, and whereby the consolidator module form and route message packages in order to minimize mail production costs. (col 4: lines 15-21)

Referring to claim 17:

Schumacher discloses

The message processing system of claim 1 wherein the consolidator selects messages for consolidation from the plurality of messages based on the messages including a same delivery address. (col 10: lines 31-40)

Referring to claim 30:

A method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

Schumacher discloses

Receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

Consolidating multiple of the plurality of messages into single message packages, said consolidating of the messages into consolidated message packages based on first criteria; (col 4: lines 36-40; col 10: lines 38-40)

determining at least some of the first criteria through a customer relationship management system wherein the step of determining the first criteria include marketing

business rules determined by the customer relationship management system. (col 4: lines 9-21)

Schumacher does not expressly disclose of preventing messages from being consolidated based on the marketing rules that include a rule that message that include particular marketing content may not be consolidated.

Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain marketing contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

Referring to claim 31:

Schumacher does not expressly disclose the method of claim 30 further comprising the step of determining a template for message packages with the customer relationship management system.

However, it would have been obvious at the time of the invention that a template for message packages is determined with the customer relationship management system. The template is determined such that the customer will receive consolidated mailing that is addressed to the customer.

Referring to claim 32:

Schumacher discloses the method of claim 31 wherein the step of determining the template comprises including marketing content developed by marketing tools in the customer relationship management system. (col 4: lines 36-40)

Referring to claim 38:

Schumacher discloses the method of claim 30 further including the step of determining at least some of the first criteria with a statement applications processing module. (col 11: lines 8-11)

Referring to claim 39:

Schumacher discloses the method of claim 38 further including the step of providing message business data from the statement applications processing module for forming the message packages. (col 11: lines 8-11)

Referring to claim 40:

Schumacher discloses the method of claim 38 wherein the step of determining at least some of the first includes incorporating sender rules received from the statement applications processing module. (col 10: lines 20-26)

Referring to claim 41:

Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be consolidated.

Savage et al disclose that consolidating business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be consolidated or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by consolidating contents.

Referring to claim 42:

Schumacher does not expressly disclose the method of claim 40 wherein the step of consolidating is controlled by the first criteria which includes a sender rule that messages that include particular business content may, or may not, be householded.

Savage et al disclose that householding business contents provides valuable cost advantages and reduce costs the senders. (col 3: lines 44-52)

Therefore, it would have been obvious at the time of the invention that Schumacher would allow the option of certain business contents to be householded or not. Schumacher would be motivated to do so to provide the senders the option of reducing cost by householding contents.

Referring to claim 43:

Schumacher discloses the method of claim 40 wherein the sender rules include a requirement to maximize throughput of message packages, and the steps of consolidating is controlled to form message packages in order to maximize throughput. (col 4: lines 22-39)

Referring to claim 44:

Schumacher discloses the method of claim 40 wherein the sender rules include a requirement to minimize mail production costs, and the wherein the steps of

consolidating is controlled to form message packages in order to minimize mail production costs. (col 4: lines 15-21)

Referring to claim 45:

Schumacher discloses the method of claim 30 wherein the step of consolidating includes selecting messages for consolidation from the plurality of messages based on the messages having a same delivery address. (col 4: lines 35-40)

Claims 6-8, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in further view of U.S. Pub No. 2004/0230523 to Johnson.

Referring to claim 6:

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose that the message processing system of claim 1 wherein the first criteria include customer preferences.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.
[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

Referring to claim 7:

Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 8:

Schumacher does not expressly disclose the message processing system of claim 6 wherein the first criteria includes a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

Referring to claim 35:

Schumacher disclose consolidating mailing inserts based on plurality of factors. Schumacher does not expressly disclose gathering customer preference data and including it in the first criteria.

Johnson disclose that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly.

[0029]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to process the messages based on customer preference. Schumacher would be motivated to perform such modification to provide convenience to the customers.

Referring to claim 36:

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which includes a customer preference on whether or not consolidation is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether consolidation is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 37:

Schumacher does not expressly disclose the method of claim 35 wherein the step of consolidating is controlled based on the first criteria which include a customer preference on whether or not householding is desired.

However, it would have been obvious at the time of the invention that Schumacher would allow the option of customer choosing whether householding is desired. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do so to provide convenience and protect the privacy and personal information of the recipient by not sending information about multiple customers to one place.

Claims 18-20, 22, 24, 25, 28, 46-48, 50, 52-53, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in further view of U.S. Pub No. 2002/0133472 to Stepno.

Referring to claim 18:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose that the message processing system of claim 17 wherein the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message

based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 19:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system of claim 18 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator.

[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 20:

Schumacher does not expressly disclose the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher

would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 22:

Schumacher does not expressly disclose that the message processing system of claim 18 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

Referring to claim 24:

Schumacher discloses a message processing system for preparing a plurality of messages to be distributed to customers, the system comprising:

A consolidator module receiving data corresponding to the plurality of messages, the consolidator module programmed to consolidate multiple of the plurality of messages into a single message package, the consolidator module consolidation the message based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Schumacher combined with Savage et al and Stepno does not expressly disclose wherein the consolidator module determines whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module is there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 25:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose the message processing system

of claim 24 wherein due dates of messages selected for consolidation are adjusted by the consolidator module to match.

Stepno discloses due dates on the message are adjusted by the consolidator.
[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 28:

Schumacher does not expressly disclose that the message processing system of claim 24 wherein the consolidator module determines whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

Referring to claim 46:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose selecting messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 47:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator. [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 48:

Schumacher does not expressly disclose determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 50:

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

Referring to claim 52:

Schumacher discloses a method for processing and preparing a plurality of messages to be distributed to recipients, the method comprising:

receiving data corresponding to the plurality of messages; (col 4: lines 36-40; col 10: lines 38-40)

consolidating multiple of the plurality of messages into a single message package, said consolidating of the messages into consolidated message packages based on first criteria, (col 4: lines 36-40; col 10: lines 38-40)

Schumacher does not expressly disclose the consolidator selects messages for consolidation based on messages having due dates proximal in time.

Stepno discloses consolidating messages based on messages having due dates proximal in time. [0015], [0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to also consolidate the message based on due dates proximal in time. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Schumacher combined with Savage et al and Stepno does not expressly disclose wherein the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message, and whereby consolidation is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art

that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

Referring to claim 53:

Schumacher disclose consolidating messages based on plurality of factors (col 4: lines 15-20). Schumacher does not expressly disclose wherein the step of consolidating includes adjusting the due dates of messages selected for consolidation so that consolidated messages have the same due dates.

Stepno discloses due dates on the message are adjusted by the consolidator.
[0022]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to adjust the due date of the messages in order to consolidate them. Schumacher provides specific motivation by disclosing the need to reduce costs for entities involved in co-mail (col 3: lines 9-15).

Referring to claim 56:

Schumacher does not expressly disclose determining whether a customer preference authorizes householding for a particular message, and whereby householding is disallowed by the consolidator module if there is no authorization.

However, it would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of householding and not perform householding unless an authorization is found. As it is well known in the art

that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing householding so to provide convenience and protect the privacy and personal information of the recipient by not sending person information of plurality of recipient to the same address.

Claims 21, 23, 27, 29, 49, 51, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher in view of Savage et al in view of Stepno in further view of Johnson.

Referring to claims 21, 23, 27, 29, 49, 51, 55 and 57:

Schumacher combined with Stepno disclose sending advertisements with the message to the recipient. (Schumacher col 4: lines 36-40) Schumacher combined with Stepno does not expressly disclose if the customer preference does not authorize consolidation or householding, the consolidator generates content to be included in the message that describes benefits of consolidation or householding.

Johnson disclose that sellers often offer discounts for quick payment. [0006] Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to send an advertisement describing the advantages of message consolidation to the recipient, such as discounts offered.

(10) Response to Argument

Applicant's arguments regarding the 35. U.S.C. § 101 rejection of claims 52, 53 and 55-57 have been fully considered but they are not persuasive.

Claim 52 is directed to a method for processing and preparing a plurality of messages which recite purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

The Applicant asserts that independent claim 52 satisfies the “transforms an item” branch of the test enunciated in *In re Bilski*, 88 USPQ2d 1385 (CAFC) (2008) in that consolidating multiple of the plurality of messages into single message packages in transforming a plurality of messages into single message packages. The Examiner respectfully disagrees. In both *Bilski* and the MPEP 2106 IV (C)(2), the transformation test is whether claimed invention “transforms an article or physical object to a different state or thing.” In the present application, the article or physical objects are the plurality of messages, by consolidating multiple messages into a single message package, a different state or thing is not created. Certainly, without argument, the messages are still in the same state. While the Applicant may assert that a different thing has been created, the Examiner disagrees, a message package is not a different thing, at most it is a group or aggregation of the same article that is the messages.

Claims 52, 53 and 55-57 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test; therefore, claims 52, 53 and 55-57 are non-statutory under § 101.

With regards to claim 30, the Applicant asserts the failure of the Examiner to enter the After Final amendment filed on February 03 2009 to eliminate the rejection of claim 30 under 35 U.S.C. §112 second paragraph reveals a strategy of obstructionism that is generally used when the merits of the arguments are weak on the other issues. The Examiner respectfully disagrees. The After Final amendment filed on February 03 2009 in addition to amending claim 30 to overcome the 35 U.S.C. §112 second paragraph rejection also introduced amendments to claims 6, 7, 8, 35, 36 and 37 in which the scope of claims 7, 8, 36 and 37 were altered. Therefore, entering the After Final amendment to over come the 35 U.S.C. §112 second paragraph rejection would also enter the amendments for claims 7, 8, 36 and 37 and would have cause undue burden on the Examiner. To reduce issues and prepare the Application in better condition for Appeal, the Applicant should have filed a response only consisting of the amendment to claim 30.

Applicant's arguments regarding claims 1-3, 9-17, 30-32, 38-45 have been fully considered but they are not persuasive.

With regards to claim 1, the Applicant asserts that Savage does not cure the deficiency of Schumacher is teaching or disclosing wherein the "marketing rules include a rule that message that include particular marketing content may, or may not, be consolidated", the Examiner respectfully disagrees. Savage et al disclose that consolidating marketing contents provides valuable cost advantages and reduce costs

to the senders. (col 3: lines 44-52) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher to have a rule to consolidate marketing content. Schumacher would have been motivated to perform such a rule to reduce costs to the senders and to take advantage of the valuable cost savings as disclosed by Savage et al.

Furthermore one of ordinary skill in the art of business methods would find it obvious to update the consolidator system of Schumacher's invention with the rules to consolidate messages to take advantage of the cost savings as disclosed by both Schumacher and Savage et al. All this would be accomplished with no unpredictable results.

With regards to claim 6-8, and 35-37, the applicant asserts that Johnson does not teach using customer preferences to determine whether consolidation or householding is desired in the first place. The Examiner respectfully disagrees. Johnson discloses that the recipient can opt for paper delivery of the consolidated bills, and allowing the post office to determine the best routing method accordingly. [0029] Therefore, the recipient by opting for paper delivery of the consolidated bills is in fact asserting their preference.

With regards to claim 52, the claim now recites the additional language of "wherein the step of consolidating includes determining whether a customer preference authorizes consolidating for a particular message, and whereby consolidating is

disallowed if there is no authorization." The applicant asserts that neither Schumacher or Stepno disclose or suggest "the step of consolidating includes determining whether a customer preference authorizes consolidation for a particular message." The Examiner respectfully disagrees. It would have been obvious at the time of the invention that Schumacher's invention would check for customer authorization of consolidation and not perform consolidation unless an authorization is found. As it is well known in the art that recipient privacy and personal information are important and therefore Schumacher would be motivated to do seek authorization before performing consolidation so to provide convenience and protect the privacy and personal information of the recipient by not having a separate entity collecting personal information.

With regards to claims 21, 23, 27, 29, 49, 51, 55 and 57, the Applicant asserts that Johnson is inadequate to serve as a teaching or disclosure of the element for purposes of making a prima facie obviousness rejection. The Examiner respectfully disagrees. Johnson teaches offering benefits to customers for performing certain actions (offering discounts for quick payment [0006]) Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for Schumacher combined with Stepno to offer benefits to customers for performing certain actions, in the present combination, the actions being providing authorization for consolidation or householding. Therefore Johnson provides adequate disclosure for the purpose of making a prima facie obviousness rejection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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